THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
Norbert Heske, et al.	)	Group: 3736
Serial No.: 10/549,818	)	
Filed: September 20, 2005	)	
Title: PRESSURE GENERATING UNIT	)	Examiner: J. Hoekstra

ARGUMENTS AND PROPOSED AMENDMENTS IN RESPONSE TO FIRST ACTION INTERVIEW PILOT PROGRAM PRE-INTERVIEW COMMUNICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the First Action Interview Pilot Program Pre-interview Communication dated March 25, 2010, and is being filed contemporaneously with the Applicant Initiated Interview Request Form.

The following papers are included herewith:

PROPOSED AMENDMENT(S) TO THE CLAIMS

1-7. (Canceled)

8. (Proposed amendment) A pressure generating unit for a biopsy apparatus carrying a biopsy needle unit, comprising:

a cylinder having an interior cylinder wall, a first cylinder space, a second cylinder space, a connector, and a connecting path, the connector being located at a first end of the cylinder adjacent the first cylinder space and configured for connection to the biopsy needle unit, the connecting path ~~extending~~ being configured to facilitate selective connection between the first cylinder space and the second cylinder space;

a piston arrangement including a piston connected to a piston spindle, the piston being movably positioned in the cylinder, a vacuum being generated in the first cylinder space by retracting the piston and the vacuum being released when the piston is positioned adjacent the connecting path; and

an absorbent element carried by the piston, the ~~absorbing~~ absorbent element being located in contact against the interior cylinder wall.

9. (Previously presented) The pressure generating unit of claim 8, wherein the absorbent element is arranged on a back side of the piston that faces away from the first end of the cylinder, the absorbent element being held in position by a securing disk attached to the piston spindle.

10. (Previously presented) The pressure generating unit of claim 8, further comprising a piston spindle drive engaged with the piston spindle to displace the piston in the cylinder, the piston spindle drive being mounted at a second end of the cylinder opposite to the first end of the cylinder having the connector, the absorbent element being located between a back side of the piston and the piston spindle drive.

11. (Previously presented) The pressure generating unit of claim 8, wherein the connecting path is an interior groove in the cylinder, and the vacuum is released when the piston and the absorbent element are positioned at the interior groove.

12. (Previously presented) The pressure generating unit of claim 8, wherein the absorbent element comprises absorbent chemical pulp.

13. (Previously presented) The pressure generating unit of claim 8, wherein the absorbent element is a paper filter.

14. (Previously presented) The pressure generating unit of claim 8, wherein the absorbent element is an air-permeable element.

15. (Previously presented) The pressure generating unit of claim 8, wherein the absorbent element includes a plurality of absorbent disks.

16. (Previously presented) The pressure generating unit of claim 8, wherein a longitudinal extent of the absorbent element in the cylinder is about three millimeters.

17. (Proposed amendment) The pressure generating unit of claim 8, wherein the piston separates the first cylinder space from the second cylinder space, and the absorbent element filters air prior to entry into the first cylinder space via the connecting path when the piston is positioned over the connecting path to release the vacuum ~~is released~~.

18. (Proposed amendment) The pressure generating unit of claim 8, wherein the absorbent element is arranged on a back side of the piston that faces away from the first end of the cylinder, and wherein the absorbent element absorbs tissue fluids to prevent a back flow of the tissue fluids from the first cylinder space.

REMARKS

Claims 8-18 are pending in the present application. Claims 8-18 were rejected. Proposed amendments are submitted herein for claims 8, 17 and 18. Preliminary to the requested interview under the First Action Interview Pilot Program, please consider the following arguments regarding the patentability of claims 8-18 over the cited references.

On April 8, 2010, Applicants' representative and the Examiner discussed Applicants' request for clarification as to the reference to Reference "B" at item #2 at page 2 of the Office Communication. The Examiner confirmed that Reference "B" should have been Reference "A" (Holcombe, et al. (US 5,368,029)).

Claims 8-11 and 16 were rejected under 35 U.S.C. 102(b) as being anticipated by Reference N (DE 202 04 363 U1). The Examiner notes that the citations in the rejection correspond to US 2005/0203439 A1, although the rejection is based on DE 202 04 363 U1, and that the disclosures of DE 202 04 363 U1 and US 2005/0203439 A1 appear to be consistent. It is noted that the inventors who are identified in DE 202 04 363 U1 are the same inventors identified in the present application.

Claim 8 recites, in part, "an absorbent element carried by the piston, the absorbent element being located in contact against the interior cylinder wall." The Examiner states that element 54 of Reference N appears to comprise two structures which may be the piston and the "absorbent element" as claimed, and relies on Figs. 13-14d and paragraphs 83-102 of US 2005/0203439 A1 in support of the rejection.

With reference to Figs. 14a and 14b of the Reference N, it is noted that the lead line of element 54 points to both parts that the Examiner perceived to be two structures. As set forth in paragraph 83 of US 2005/0203439 A1, reference is made to a single item, plunger 54, and

more particularly it is stated, "In the upper, rear, right region, the vacuum pressure-generating device 5 is arranged as a piston/cylinder unit 69. It consists of a syringe body 52 with threaded spindle 53 arranged inside, at whose end facing the syringe bottom 51 there is fastened a plunger 54 with seal elements--as is commonly known with syringes (FIG. 14a-14d)." (Emphasis added). Moreover, there is no reference anywhere in the disclosure of US 2005/0203439 A1 to an absorbent element carried by the plunger 54.

In addition, by comparing Figs. 13-14d of Reference N to Figs. 2-4 of the present application, it can be seen that in the structure of the present application there is an additional structure expressly identified as "absorbent element 14", which is described in the specification of the present application at page 4, second paragraph (paragraph [0021] as published). As set forth in the specification of the present application at page 4, second paragraph, "Arranged on the side wall 13 of the piston, which is in the cylinder space 12, is an absorbent element 14 that is penetrated coaxially by the piston spindle and that is held, for example by means of a securing disk 18 that is attached to the piston spindle."

Accordingly, it is respectfully submitted that the structure disclosed in Reference N differs from the structure disclosed in the present application, in that Reference N does not include an absorbent element carried by the piston, and thus Reference N does not disclose, teach, or suggest at least the absorbent element as recited in claim 8.

In addition, claim 8 in accordance with the proposed amendment recites, "a cylinder having an interior cylinder wall, a first cylinder space, a second cylinder space, a connector, and a connecting path..., the connecting path being configured to facilitate selective connection between the first cylinder space and the second cylinder space" and "the piston being movably positioned in the cylinder, a vacuum being generated in the first cylinder space

by retracting the piston and the vacuum being released when the piston is positioned adjacent the connecting path;". In contrast, Reference N (paragraph 86 of 2005/0203439 A1) discloses a ventilation opening 67 that passes through the side wall of syringe body 52.

Accordingly, it is respectfully submitted that Reference N also does not disclose, teach, or suggest the connecting path as recited in the proposed amended claim 8.

Claims 9-11 and 16 depend from claim 8, and are believed allowable for the reasons set forth above with respect to claim 8. In addition, claims 9-11 and 16 further recite aspects of the absorbent element that are not disclosed, taught, or suggested by Reference N, and thus, claims 9-11 and 16 are believed patentable in their own right.

Claims 12-15, 17 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Reference N (DE 202 04 363 U1) in view of Reference A (Holcombe, et al. (US 5,368,029)). The Examiner states that building on the rejection of claim 8, Reference A discloses the structure of the absorbent element, referring to Reference A, column 11, line 16-column 13, line 27, and Figs 6A-6C.

Claims 12-15, 17 and 18 depend from claim 8, and are believed allowable because Reference A does not overcome the deficiencies of Reference N set forth above with respect to claim 8.

For example, claim 8 recites, in part, "an **absorbent element** carried by the piston, the absorbent element being located in contact against the interior cylinder wall." (Emphasis added). As set forth above, Reference N does not disclose an absorbent element.

With respect to Reference A, it is presumed that the Examiner is referencing test strip 140 as corresponding to the recited absorbent element, as the Examiner did in related application 11/680,900. In Reference A, the test strip 140 is integrally formed as an elongate

shaft at the far end of piston 130, and extends downstream of piston seal 136 toward flash chamber 115 (see Ref. A column 11, ll. 59-63, Figs. 6A-6C). However, test strip 140 is not located in contact against the interior cylinder wall of cylindrical housing 111.

It is further noted that in Reference A, the absorbent element 120 is not carried by piston 130, and has a central aperture 121 through which the test strip 140 selectively extends. (Ref. A column 12, ll. 13-17, Figs. 6A-6C). Also, it is noted that Reference A does not disclose the recited cylinder having the connecting path configured to facilitate selective connection between the first cylinder space and the second cylinder space, as recited in the proposed amended claim 8.

Accordingly, it is respectfully submitted that Reference N in view of Reference A does not render obvious the subject matter of base claim 8, and thus in turn does not render obvious the subject matters of dependent claims 12-15, 17 and 18.

In addition, for example, claim 15 recites, "The pressure generating unit of claim 8, wherein the absorbent element includes a plurality of absorbent disks." It is respectfully submitted that Reference N in view of Reference A does not disclose the structure as recited in claim 15. Accordingly, claim 15 is believed allowable in its own right.

Proposed amendments are provided to dependent claims 17 and 18 to provide further basis for finding each of the subject matters of claims 17 and 18 respectively patentable in its own right over Reference N in view of Reference A.

For the foregoing reasons, Applicants respectfully submit that claims 8-18 are patentable over Reference N and/or Reference N in view of Reference A.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby

conditionally petition therefor and authorize that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (317) 894-0801.

Respectfully submitted,

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